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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,331	03/01/2002	Susan M. F. Davis	10012623-1	3076

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EXAMINER

WU, RUTAO

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/087,331	Applicant(s) DAVIS, SUSAN M. F.	
	Examiner Rob Wu	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. In response filed April 20, 2006 no amendments has been filed. Claims 1-20 are pending in the current application.

Response to Arguments

2. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 15-20, the claims are directed to software per se which is not embodied on a computer readable medium.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the

Art Unit: 3628

data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4, 5, 7, 10, 11, 13-15, 17, 18, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pub No. 2003/0105730 to Rhoads et al.

Referring to claim 1:

An information delivery system, comprising:

A postage system configured to apply postage and a network address to objects in a postage field on the objects wherein the postage field comprises an area reserved on the object for the postage and wherein the objects are delivered to the user; and

[0010]

A server system configured to receive a first message over the Internet from one of the users, wherein the first message is addressed to the network address, process the first message to retrieve information, and transfer the information in a second message over the Internet to the one of the users. [0010]

Referring to claim 4:

The information delivery system of claim 1 wherein the postage system comprises a postage printing device configured to receive weight information for the objects and apply the postage based on the weight information. [0014]

Referring to claim 5:

The information delivery system of claim 1 wherein the network address comprises an Internet address. [0010]

Referring to claim 7:

A method of operating an information delivery system, the method comprising:
applying postage and a network address to objects in a postage field on the objects wherein the postage field comprises an area reserved on the object for the postage and wherein the objects are delivered to the user; and [0010]

receiving a first message over the Internet from one of the users, wherein the first message is addressed to the network address; [0010]

processing the first message to retrieve information; [0010]

transferring the information in a second message over the Internet to the one of the users. [0010]

Referring to claim 10:

The method of claim 7 further comprising receiving weight information for the objects and apply the postage based on the weight information. [0014]

Referring to claim 11:

The method of claim 7 wherein the network address comprises an Internet address. [0010]

Referring to claim 13:

The method of claim 7 further comprising generating a postmark that includes the network address. [0010]

Referring to claim 14:

The method of claim 13 further comprising paying a delivery service to cancel the postage using the postmark that includes the network address. [0025]

Referring to claim 15:

A software product for a processing system that is configured to operate with a postage system, the software product comprising:

Application software configured when executed by the processing system to direct the processing system to generate an instruction to apply postage and a network address to objects in a postage field on the objects wherein the postage field comprises an area reserved on the objects for the postage and wherein the objects are delivered to users, transfer the instruction to the postage system, receive a first message over the Internet from one of the users wherein the first message is addressed to the network address, process the first message to retrieve information and transfer the information in a second message over the Internet to the one of the users; [0010] and

A storage media configure to store the application software. [0027]

Referring to claim 17:

The software product of claim 15 wherein the application software is further configured to direct the processing system to receive weight information for the objects, generate a postage instruction based on the weight information, and transfer the postage instructions to the postage system. [0014]

Referring to claim 18:

The software product of claim 15 wherein the network address comprises an Internet address. [0010]

Referring to claim 20:

The software product of claim 15 wherein the application software is further configured to direct the processing system to change the network address applied to the objects. [0019]

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 6, 8, 9, 12, 16, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads et al.

Referring to claims 2, 8 and 16:

Art Unit: 3628

Rhoads et al disclose that the postage can be applied to an adhesive-backed medium that is affixed to an envelope, or can be applied directly to the envelope. [0006] However, Rhoads et al does not expressly states that the postage and the network address is applied at a consistent location on the object.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the postage with the network address is applied at a consistent location to facilitate automatically scanning. The reason being that it is a well known standard to apply postage to the top right corner of a package or a envelope.

Referring to claims 3, 9:

Rhoads et al disclose that the URL can be scanned to load the webpage at the specified URL. [0010] Thus it is inherent that once the URL is scanned, a message is send to the webpage initiating the loading of the webpage. Rhoads et al however does not expressly state that scanning of the network address is done automatically.

However, providing an automatic or mechanical means to replace a manual activity, which accomplishes the same result, is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)

Referring to claims 6, 12 and 19:

Rhoads et al disclose that the postage is able to include a network address such as a URL. [0010] Rhoads et al does not expressly disclose that wherein the network address comprises a domain name.

However, it would have been obvious at the time of the invention for Rhoads et al to also print a domain name instead of a full URL. Rhoads et al would be motivated to do so because it is well known in the art that no matter which format is used, both are resolved by the Domain Name System (DNS) which informs the computer of the IP address assigned to that name.

Conclusion

8. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Wu whose telephone number is (571)272-3136.

The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rw


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER